

AMENDMENTS TO THE DRAWINGS:

In the first paragraph on page 3 of the Office Action, the Examiner objected to the specification based on 37 CFR § 1.175(d)(1) and MPEP § 608.01(o) due to use of the term "expression information" in claim 7. The text in Fig. 9C has been amended to add the word "EXPRESSION" prior to the phrase "INFORMATION ABOUT THE PLACE WHERE THE COMMENT IS MADE" which corresponds to the "expression information of said place" (claim 7, line 3), where "said place" refers to "any arbitrary place in said page" (claim 1, lines 3-4).

In the third and fourth paragraphs on page 3 the Office Action, the Examiner objected to the drawings. To overcome these objections, replacement figures are submitted herewith. In FIG. 7, reference numeral "33" has been changed to --34-- and in Fig. 11, reference numeral --46-- has been added to Fig. 11 connected to the window which is pointed to by the arrow from the box associated with reference numeral 45.

Approval of these changes to the Drawings is respectfully requested.

REMARKS

In the October 5, 2004 Office Action, the Examiner noted that claims 1-25 were pending in the application; objected to the disclosure for informalities and under 37 CFR § 1.75(d)(1) and MPEP § 608.01(o); objected to the drawings under 37 CFR § 1.84(p)(5); objected to claims 3, 5, 8, 12, 14, 16-18, 19, 20, 22 and 25 due to informalities; rejected claims 1, 2, 4, 5, 7 and 9-25 under 35 USC § 102(e); and rejected claims 3, 6 and 8 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 6,714,214 to DeMello et al.; 6,687,878 to Eintracht et al.; and 5,822,543 to van Hoff (References A-C, respectively) were cited. Claims 2, 9, 14, 17 and 20-25 have been cancelled, and thus, claims 1, 3-8, 10-13, 15, 16, 18 and 19 remain in the case. The Examiner's rejections are traversed below.

Priority

In the first paragraph on page 2 of the Office Action, the Examiner indicated "that applicant has not filed a certified copy of the Japanese application as required by 35 USC 119(b)." Submitted herewith as Exhibit A is a copy of the Utility Patent Application Transmittal, the first page of the certified application (Japanese Patent Application 2000-344344), the English translation thereof, and one of the postcard receipts indicating that the priority document was submitted when the application was filed on March 29, 2001. The Examiner is respectfully requested to determine what happened to the certified copy of the priority application filed on March 29, 2001 and indicate whether another copy must be submitted to meet the requirements of 35 USC § 1.119(b).

Objections to Specification

On the second half of page 2 of the Office Action the Examiner objected to four bulleted items in the specification due to informality and provided the changes that must be made to the last three items. The required changes have been made and the typographical error "unittoring" identified in the first item has been replaced with the words "--result in storing--" that are an obvious correction from reading the specification. Therefore, no "new matter" has been added and withdrawal of the objections to the specification due to informality is respectfully requested.

On page 3 of the Office Action, the Examiner objected to the specification as failing to provide proper antecedent basis for the term "expression information" recited in claim 1. Fig. 9C has been amended to add the word "EXPRESSION" prior to the phrase "INFORMATION ABOUT THE PLACE WHERE THE COMMENT IS MADE" which corresponds to the "expression information of said place" (claim 7, line 3) since "said place" refers to "any arbitrarily place in said

page” (claim 1, lines 3-4). Therefore, withdrawal of the objection under 37 CFR § 1.75(d)(1) and MPEP 608.01(o) is respectfully requested.

Objections to Drawings

In the third paragraph on page 3 of the Office Action, the Examiner objected to Fig. 7 because the reference number “33” should have been --34--. The required change has been made to Fig. 7.

In the fourth paragraph on page 3 of the Office Action, the Examiner objected to the drawings under 37 CFR § 1.84(p)(5) due to failure to use the reference numeral 46 on page 26, line 7 of the specification. Fig. 11 has been amended to add reference numeral 46 as corresponding to the “save file designation window” (page 23, lines 6 and 8). Therefore, withdrawal of the objection to the drawings under 37 CFR § 1.84(p)(5) is respectfully requested.

Objection to Claims

On pages 4-6 of the Office Action, the Examiner objected to claims 3, 5, 7, 8, 12, 14, 16-20, 22, 23 and 25 due to informalities. These objections have been addressed by amendment or cancellation of the specified claims. Therefore, withdrawal of the objections to the claims is respectfully requested.

Rejections under USC § 102(e)

On pages 7-13 of the Office Action, the Examiner rejected claims 1, 2, 4, 5, 7, 9-12 and 23-25 under 35 USC § 102(e) as anticipated by DeMello et al. Since claims 23-25 have been cancelled, only the rejection of claims 1, 2, 4, 5, 7 and 9-12 be addressed.

Nothing has been found at any of the portions of DeMello et al. cited in rejecting the claims, or elsewhere, that DeMello et al. teaches or suggests “appending desired comment information to any arbitrary place of graphical information” (e.g., claim 1, lines 3-4) in a page of markup language displayed by a browser. Rather, as illustrated in Figs. 2 and 3A, DeMello et al. is solely text based. It is well known in the art that associating text with text is a relatively simple operation, while associating text and images or “graphical information” is more complex, due to the difficulty of identifying what graphical images are associated with what text, how to relate the text with positions on a display screen, etc. Clearly, DeMello et al. does not **anticipate** the amended claims. Furthermore, it is submitted that it would not be obvious to modify the system disclosed by DeMello et al. to associate comment information with graphical information in the manner recited in the claims, so that comment information is appended to a place on a web

page at which graphical information is displayed, but the information is stored separately from the web page, e.g., in a separate file that can be sent to any other person to enable the recipient of the file containing the comment to view the web page displayed in such a manner that the comment information is merged with the web page.

Since claim 9 recites "appending desired comment information to a desired place of graphical information on the page of the markup language" (claim 9, lines 4-5) and claims 4, 5, 7, 11 and 12 depend from claim 1 or claim 9, it is submitted that claims 1, 4, 5, 7, 9, 11 and 12 patentably distinguish over DeMello et al.

On pages 13-20 of the Office Action, claims 13-22 were rejected under 35 USC § 102(e) as anticipated by Eintracht et al. Claim 13 has been amended to recite "storing comment information associated with a related page" (claim 13, line 3, added text underlined). Nothing has been found in the cited portions or elsewhere in Eintracht et al. teaching or suggesting that comment information is associated with a **related** page, where the comment information includes "address information of the related page, specified place information in said page, and comment text" (claim 13, lines 4-5). Merely logging "all annotation activities along with information about the corresponding clients that create, edit and retrieve them" (Eintracht et al., column 6, lines 52-54) by the Notes Server described in more detail in column 10, does not meet the limitation quoted from claim 13.

As a result of storing comment information associated with a related page in the storing unit, a display controlling unit is able to control display by a client apparatus of the "comment information in association with the specified place information in said page ... when there is comment information related to said page" (claim 13, last three lines). The system taught by Eintracht et al. is unable to provide the benefit of displaying information from a related page in this manner. Since claim 16 has been amended to recite "said comment information that can be displayed . . . in association with specified place information in said page" (claim 16, lines 4-5), it is submitted that claims 13 and 16 and claims 15 and 18 which depend therefrom patentably distinguish over Eintracht et al. for the reasons discussed above.

Claim 19 has not been amended, because claim 19 has always recited "comment information related to the displayed page" (claim 19, line 3) and "displaying the comment information corresponding to the instructed place according to an instruction that said displayed page should be detected" (claim 19, last two lines). Nothing has been found in Eintracht et al. teaching or suggesting these operations. Therefore, it is submitted that claim 19 patentably

distinguishes over Eintracht et al. for reasons similar to those discussed above with respect to claims 13 and 16.

Rejections under 35 USC § 103

On pages 20-25, claims 3, 6 and 8 were rejected under 35 USC § 103(a) as unpatentable over DeMello et al. in view of van Hoff. Nothing has been found in van Hoff suggesting modification of DeMello et al. to overcome the deficiencies discussed above with respect to claim 1. Since claims 3, 6 and 8 depend from claim 1, it is submitted that claims 3, 6 and 8 patentably distinguish over DeMello et al. in view of van Hoff.

Summary

It is submitted that the cited references, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1, 3-8, 10-13, 15, 16, 18 and 19 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

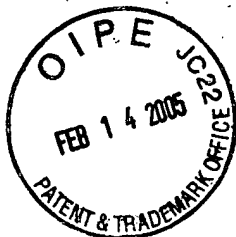
STAAS & HALSEY LLP

Date: 2/7/05

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE UNDER 37 CFR 1.0(a)
I hereby certify that this correspondence is being deposited
with the United States Postal Service as first class mail in
an envelope addressed to: Commissioner for Trademarks,
2900 Crystal Drive, Arlington, VA 22202-3514
on 2/7/2005
By: Richard A. Gollhofer
Date: 2/7/05



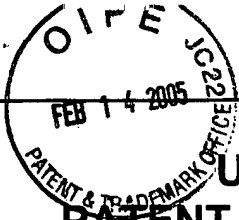
Please return this card, indicating receipt date and Serial No., if applicable, of the following
New Utility Patent Application, Fee Transmittal including Spec. 32 pgs., Claims 9 pgs.,
Abstract 1 pg., Decl/POA 3 pgs., Drawings 14 sheets, PTO Form 1595 & Assignment,
Priority Doc., Check \$1480 (710 ff+40 assgn+640 ext. ind. claims+ 90 ext total clms)

Applicant(s): Masahiro KURISHIMA, et al.
Title: CLIENT APPARATUS AND RECORDING MEDIUM THAT RECORDS A
PROGRAM THEREOF
Serial No.:
Filing Date: March 27, 2001
Docket No.: 826.1724/JDH
Due Date: APRIL 10, 2001



COPY

EXHIBIT "A"

**UTILITY
PATENT APPLICATION
TRANSMITTAL**

Attorney Docket No. 826.1724

First Named Inventor or Application Identifier:

Masahiro KURISHIMA, et al.

Express Mail Label No.

(Only for new nonprovisional applications under 37 CFR 1.53(b))

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

**Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231**

1. ☒ Fee Transmittal Form
2. ☒ Specification, Claims & Abstract [Total Pages: 42]
3. ☒ Drawing(s) (35 USC 113) [Total Sheets: 14] [FIGS. 1-14]
4. ☒ Oath or Declaration [Total Pages: 3]
- a. ☒ Newly executed (original or copy)
- b. ☐ Copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional with Box 17 completed)
- i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s) named in the prior application,
see 37 CFR 1.63(d)(2) and 1.33(b).
5. ☐ verified Statement Claiming Small Entity Status
6. ☐ Applicant Data Sheet. See 37 C.F.R. 1.76
7. ☐ CD-Rom or CD-R in duplicate, large table or Computer Program (Appendix)
8. ☐ Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
- a. ☐ Computer Readable Form (CRF)
- b. ☐ Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
- ii. ☐ paper
- c. ☐ Statement verifying identity of above copies

COPY

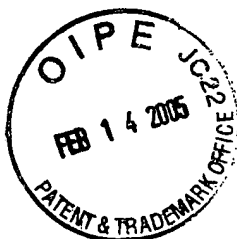
ACCOMPANYING APPLICATION PARTS

9. ☒ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement (when there is an assignee) [] Power of Attorney
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 [] Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☒ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Request and Certification under 35 U.S.C. 122(b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent
17. ☐ Other:

18. CORRESPONDENCE ADDRESS

21171

PATENT TRADEMARK OFFICE



Docket No. 826.1724

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Masahiro KURISHIMA, et al.

Serial No.: To be assigned

Filed: March 27, 2001

For: CLIENT APPARATUS AND
RECORDING MEDIUM THAT
RECORDS A PROGRAM
THEREOF

Group Art Unit: Unassigned

Examiner: Unassigned

COPY

**SUBMISSION OF CERTIFIED COPY OF PRIOR FOREIGN
APPLICATION IN ACCORDANCE
WITH THE REQUIREMENTS OF 37 C.F.R. §1.55**

*Assistant Commissioner for Patents
Washington, D.C. 20231*

Sir:

In accordance with the provisions of 37 C.F.R. §1.55, the applicant submits herewith a certified copy of the following foreign application:

Japanese Patent Application No. 2000-344344
Filed: November 10, 2000.

It is respectfully requested that the applicant be given the benefit of the foreign filing date as evidenced by the certified papers attached hereto, in accordance with the requirements of 35 U.S.C. §119.

Respectfully submitted,

STAAS & HALSEY LLP

Date: March 27, 2001

By: _____

James D. Halsey, Jr.
Registration No. 22,729

700 Eleventh Street, N.W.
Suite 500
Washington, D.C. 20001
(202) 434-1500

日本国特許庁
PATENT OFFICE
JAPANESE GOVERNMENT

COPY

別紙添付の書類に記載されている事項は下記の出願書類に記載されて
る事項と同一であることを証明する。

This is to certify that the annexed is a true copy of the following application as filed
in this Office.

出願年月日
Date of Application:

2000年11月10日

願番号
Application Number:

特願2000-344344

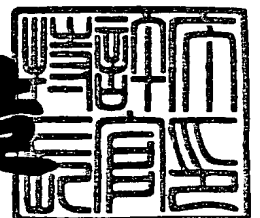
願人
Applicant(s):

富士通株式会社

2001年 2月16日

特許庁長官
Commissioner,
Patent Office

及川耕造



出証番号 出証特2001-3007753